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The Winds of Change Are Blowing Again -Even Design Patents Get a Makeover

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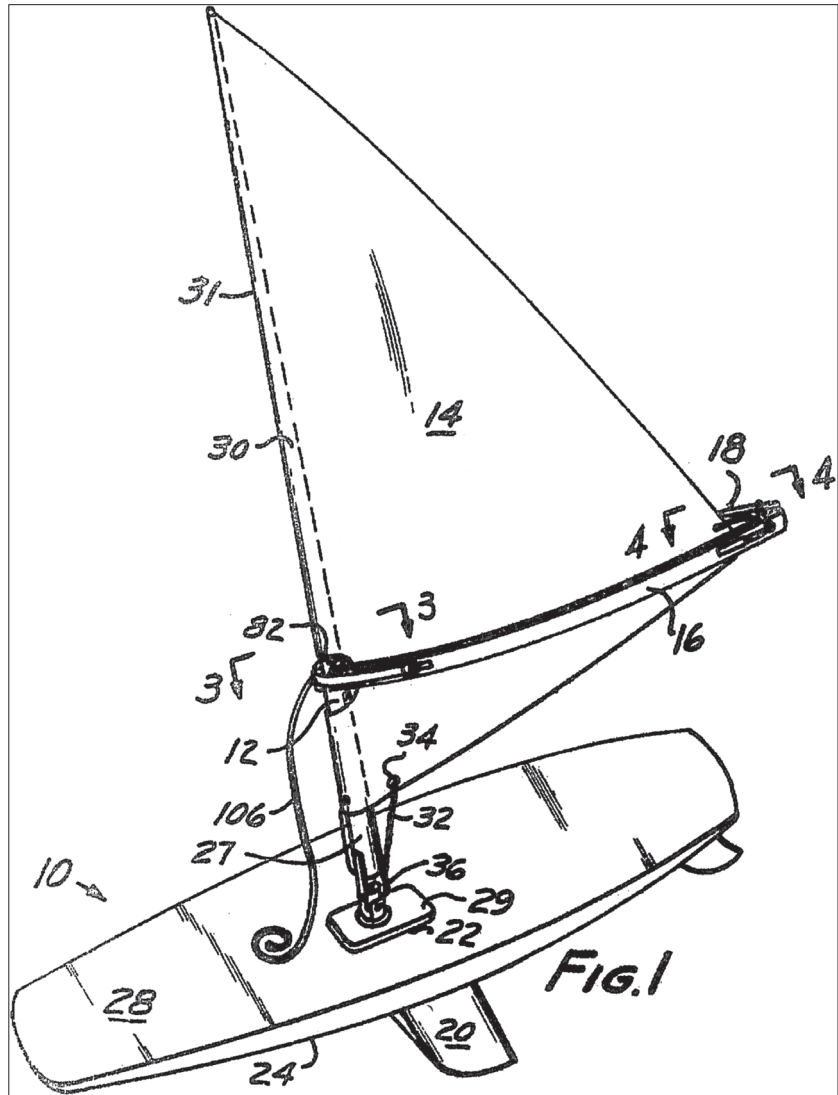
Design Patents in the Spotlight

With the growing importance of design patents in the computer and smart phone industry, as evident by the power of Apple's design patent D604,305 against Samsung¹ for the ornamental appearance of their GUI (Graphical User Interface), it was only a matter of time before design patents felt the winds of change. Frankly, as practitioners, we are a bit worn out with all of the new laws, rules, and procedures that were brought about by the America Invents Act. Patents have always been a complex undertaking, and these changes have brought that complexity to an entirely new level. Simplicity is a term that has no relevance in the field of patent law.

The New Law

The Patent Law Treaties Implementation ACT (PLTIA) was signed into law on December 18, 2012 and is the implementing legislation for the Geneva Act of the Hague Agreement that deals with international registration of industrial designs as well as the Patent Law Treaty. The Hague Agreement has been in effect since 1928, and provides a mechanism for inventors and companies in many countries to register their international designs². The United States has not been a part of this Hague system, which is administered by the World Intellectual Property Organization. The system has some similarities to a Patent Cooperation Treaty (PCT) patent application, but also has many differences.

A brief outline of the major changes that are the result of the Patent Law Treaties Implementation Act are provided in this article. These changes are set to take effect on December 18, 2013, but the Office of PCT Legal Administration at the USPTO has indicated that implementation may extend beyond this deadline. As this article is being written, we note that there is currently a lack of information on the USPTO



website regarding these substantial and important changes to design patent practice. Hopefully, more information will be forthcoming, but you may want to write down this date in pencil.

An Extra Year of Patent Term

Under the PLTIA Act, design patents will now get an extra year of patent term. For new U.S. filings (not international design application filings through the Hague system), design patents will have a term of 15 years from the date of

issue, compared to the current 14 year term. U.S. design patents do not currently require payment of maintenance fees, and this will not change as a result of the new law.

International Design Applications²

The U.S. will become a part of the Hague system, which allows for the registration of an industrial design through the World Intellectual Property Organization (WIPO). This enables the owner of the industrial design to file one application, in one language, and with one currency for the payment of fees. International registration through the Hague System produces the same effects in each of the designated countries as it would have, had the design been registered in each of the national offices of those designated countries. This registration process is just that, registration. Examination on substantive grounds, as is done with a United States Design Patent Application, is not performed. There is, however, a process where a national office can refuse registration, so in a sense, examination is done at the national level, and not by WIPO. The duration of initial registration is five years, and can be renewed in five year increments. In addition, an International Design Application can include multiple design variations, as compared to a U.S. Design Patent Application where only one design will be examined. The International Design Application may be filed directly with the United States Patent and Trademark Office once the effective date has passed.

Publication

An International Design Application publishes soon after filing, unlike a U.S. Design Application that does not publish until it issues. Thus, an International Design Application becomes prior art as of filing. This has important implications, both good and bad, for many companies. Establishing prior art quickly has competitive advantages in many countries. The tradeoff, however, is that designs are often revealed to the public before the product is available.

Provisional Rights For Infringement

First, we note that provisional rights discussed here have absolutely nothing to do with provisional patent applications. An International Design Application provides for the assertion of provisional patent rights against an infringer while the patent application is still pending. A royalty can then be recovered upon issuance of the patent from the time of notice. With U.S. design patents, infringement rights start upon the issue date of the design patent. If an applicant wishes to seek damages against an infringing competitor, an International Design Application provides a vehicle for earlier access to damages than does a United States Design Patent Application.

International vs. U.S. Design Applications

The Hague System for the registration of international designs, while certainly not new, is new for the United States. There are many benefits to an International Design Application, but it does not replace a U.S. Design Patent Application. In some instances, there may be reasons for filing both. In addition, there are now many more options for priority claims, as a foreign application often times can be used for a U.S. priority claim. For example, an International Design Application can be used for a U.S. Design Application priority claim, and an International Design Application designating the U.S. may claim priority to a prior foreign application, a PCT application designating one country other than the U.S., or a prior International Design Application designating one country other than the U.S. Priority claims for design applications must, however, be made within six months from filing.

As the world of International Design Applications is opening for the United States, a proper understanding of their importance to your overall intellectual property strategy is important. Our September 2010 article entitled “International Design Registration Through The Hague System” is an excellent place to start. Strategic issues related to their use, and their interrelationship with U.S. design application practice should be done with the help of a practitioner well versed in both.

1. See “[The Limited Monopoly™](#)” September 2013.
2. See “[The Limited Monopoly™](#)” August 2010.

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PHOTO CREDIT: United States Patent 3,487,800. Jan. 6, 1970. Wind-Propelled Apparatus. Drake and Schweitzer. (The first windsurfer patent, albeit not a design patent.)